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AP 8-15-05

In re Application of  
HESSEL et al

Application No.: 10/470,658

Filing Date: March 28, 2005

Attorney's Docket No.: 59866.000004

For: A METHOD FOR DETECTING, SCREENING,  
AND/OR MONITORING A CANCER IN  
AN INDIVIDUAL

AUG 15 2005

HUNTON & WILLIAMS LLP  
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: DECISION ON

: PETITION

: UNDER 37 CFR 1.182

This is in response to the petition under 37 CFR 1.182, filed July 28, 2005, requesting removal of the preliminary amendment from national stage application 10/529,479 and be accorded the status as a separate application by being placed in a new file wrapper and assigned a new application number, with the new application being accorded a filing date of March 28, 2005 in a application filed under 35 U.S.C. 111(a). The petition is GRANTED.

### BACKGROUND

On September 26, 2003, applicant filed international application PCT/DK2003/000634, which claimed priority of an earlier Danish application filed September 26, 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on April 8, 2004. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on March 28, 2005 (March 26, 2005 was a Saturday).

On March 28, 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; an application data sheet; and a preliminary amendment. An oath or declaration as required by 35 U.S.C. 371(c)(4) and the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) was not filed. These papers were assigned application number 10/529,479.

On July 28, 2005, applicant filed the present petition requesting removal of the preliminary amendment from the national stage and the establishment of a patent application filed under 35 U.S.C. 111(a) with a filing date of March 28, 2005. The petition was accompanied by a copy of the international application, a copy of the preliminary amendment

filed March 28, 2005, an authorization to charge the \$400 petition fee, and the filing fee to applicant's attorney's deposit account, and a second preliminary amendment.

### DISCUSSION

Applicants assert that the filing of the preliminary amendment on March 28, 2005 could raise the issue of new matter. Applicant has filed, as part of the initial 371 filing, a preliminary amendment which contains new matter. Therefore, he is seeking that the amendment to the international application be granted a filing date of March 28, 2005. Applicant has requested removal of the preliminary amendment from the national stage file, creation of a new file wrapper, and according the new application a filing date under 35 U.S.C. 111(a) as of the date of receipt of the preliminary amendment. Applicant has stated that if the petition is not granted, the filing date of the additional subject matter will be lost. Such a situation is analogous to the filing of a similar amendment or substitute specification in a request for a CPA which is discussed in MPEP 201.06(d) which states, in part:

In the event that a substitute specification or preliminary amendment containing new matter was filed with a request for a CPA, applicant may file a petition under 37 CFR 1.182 requesting that the substitute specification or preliminary amendment be removed from the CPA application file, and be accorded the status as a separate application by being placed in a new file wrapper and assigned a new application number, with the new application being accorded a filing date as of the date the request for a CPA and substitute specification/preliminary amendment were filed. Of course, a request for a CPA is not improper simply because the request is accompanied by a substitute specification or preliminary amendment containing new matter. Thus, an applicant will not be entitled to a refund of the filing fee paid in a proper CPA as a result of the granting of a petition under 37 CFR 1.182 requesting that the substitute specification or preliminary amendment be removed from the CPA application file.

Applicant has complied with the above noted requirements. Furthermore, it is noted that on March 28, 2005 applicant filed a copy of the international application accompanied by the preliminary amendment. Thus applicant had everything necessary to accord a filing date, as of that date. Accordingly, the petition requesting that the preliminary amendment be removed from the national stage application file, and be accorded the status as a separate application by being placed in a new file wrapper and assigned a new application number, with the new application being accorded a filing date as of the date the preliminary amendment was filed is granted.

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit a certified copy of the priority document. The certified copy of priority document submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

DECISION

The petition under 37 CFR 1.182 requesting that the preliminary amendment be removed from the national stage application file, and be accorded the status as a separate application by being placed in a new file wrapper and assigned a new application number, with the new application being accorded a filing date as of the date the preliminary amendment was filed is GRANTED.

This application (10/470,658) will be processed as an application under 35 U.S.C. 111(a) and application 10/529,479 will continue to be processed as an application under 35 U.S.C. 371.

The \$400.00 petition fee will be charged to counsel's Deposit Account No. 50-0206.

A copy of the petition and this decision will be placed in both application files.

This application (10/470,658) will be forward to the Office of Initial Patenting Examination for appropriate processing. Application 10/529,479 will be returned National Stage Processing Division of the International Division for appropriate processing.

Any period of adjustment to the term of a patent under 35 U.S.C. 154(b)(May 29, 2000) in either application No. 10/470,658 or application No.10/529,479 may be reduced by the period of time beginning on the filing date accorded under 35 U.S.C. 111 and ending on the mailing date of this decision. See 37 CFR 1.704(a).

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.



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